REMARKS

Claim 1 has been further amended in several respects. First, to recite that the cost for a parking period is computed upon termination of the parking period, based upon paragraph [0026] of the specification. Second, to clarify that the communication from the mobile telephone is a direct communication with the receiving computer in which parking information is stored, as disclosed in paragraph [0017] of the specification. And third, to clarify that the information contained in the parking system's receiving computer is continuously updated by virtue of the log-in information provided by the parking system users upon entering the system, based upon the disclosures contained in paragraphs [0013] and [0015] of the specification.

Claims 1, 2, and 4 through 8 were rejected as obvious based upon the combination of the Ilén, Ouimet et al., and Cornelison references that were cited and relied upon by the examiner. The Ilén reference was construed as disclosing the basic method as claimed. However, the examiner acknowledged that the Ilén reference did not disclose voice communications. The Ouimet et al. reference was cited for disclosing a voice communication, but the examiner acknowledged that that reference does not disclose a voice message that is received by the parking attendant. The Cornelison reference was said to teach two-way voice communications of license plate numbers and in combination with the Ilén and Ouimet et al. references was said by the examiner to render the claimed invention obvious to one of ordinary skill in the art.

In addition to the examiner's acknowledgment of the absence of

any teaching in the Ilén reference of voice communication, that reference relates to a different parking system, one in which a parking fee is prepaid. In that regard, see, for example, Ilén, col. 1, lines 7 and 8, lines 12 and 13, lines 37 and 38, and lines 66 and 67; col. 2, lines 42 and 43; col. 3 lines 5 and 6; col. 4, lines 49 through 51; col. 5, lines 20 and 21; and col. 6, lines 26 through 28. Each of those portions of the Ilén reference relates to prepayment of a parking fee, and although the disclosures use the present tense in connection with the terms "parking fee," the context of the disclosures clearly contemplate a parking fee prepayment for a predetermined period of time, not a parking fee that is determined upon termination of a parking period, as claimed herein.

In addition to a system involving a fee prepayment, rather than one "for computing the cost for a parking period upon termination of the parking period" as claimed in claim 1, Ilén specifically teaches a parking system arrangement in which a sticker having a vehicle code is placed on the windshield and is read by a read head of a control device carried by a parking attendant. The sticker has a bar code or some other control-device-readable identification means. The bar code or other identification means is read and the information is transmitted as data to a parking fee register, which then sends an SMS message to the control unit. Thus the communications between the various components of the Ilén arrangement are all either non-voice data transmissions or non-voice text messages, not two-directional voice messages as in the claimed invention. The attendant must both operate the read head of the control unit, to read the windshield sticker, and also to read on the control unit display the information

supplied in SMS form from the parking system register. The Ilén reference therefore discloses a parking system method that is significantly different from the present invention as claimed.

As in the Ilén reference, the Ouimet et al. reference also relates to a prepayment system, not one "for computing the cost for a parking period upon termination of the parking period" as claimed in claim 1. It also is based upon a system in which a number of payment terminals are provided in an urban parking system (see, e.g., Ouimet et al., col. 2, lines 6 and 7; and col. 3, lines 16 and 17) in which prepayment for parking is the basis for operation of the system. For teachings of prepayment in Ouimet et al. see, for example, Abstract, lines 8 through 10; col. 2, lines 34 and 35, and lines 54 and 55; col. 3, lines 58 through 60; col. 4, lines 10 and 11; and col. 5, lines 51 and 52.

And in addition to the significant difference involving the prepayment requirement as disclosed in the Ouimet et al. reference, that reference also does not disclose "sending to the attendant via the control unit a voice message," as claimed in claim 1. Instead, the communication to the portable terminal carried by the attendant is in the form of "data retrieved and displayed on the LCD screen 51" (see, Ouimet et al., col. 5, lines 23 and 24), and it includes identification of the payment terminal that was used by the parking customer "when parking was purchased." Thus, the parking system operating method as disclosed in the Ouimet et al. reference is clearly different from and distinguishable over the claimed method.

With respect to the Cornelison reference, a system including a base

station computer of a parking violation enforcement system is arranged to communicate with a number of stand-alone computers, each of which is assigned to a parking enforcement officer (see Cornelison, col. 2, line 15). The stand-alone computers are located either in a vehicle (see Cornelison, col. 2, line 55) or in a building (see Cornelison, col. 2, lines 59 and 60). A police officer has a hand-held communication unit and communicates by radio with his assigned stand-alone computer (see Cornelison, col. 2, lines 44 through 46).

In the Cornelison reference, a base station computer contains a database of previously unpaid parking violations and is periodically, but not continuously, updated from a mainframe computer (see Cornelison, col. 2, lines 63-67). The enforcement officer communicates with his assigned stand-alone computer, not directly with the mainframe computer and not directly with the base station computer. But information contained in the stand-alone computer with which the enforcement officer communicates is not current – it only includes the information that was contained in and transferred from the base station computer to the stand-alone computer by a disk at the start of a day or at the start of a shift (see Cornelison, col. 2, line 67 through col. 3, line 2). Consequently, the enforcement officer using the Cornelison system does not have available to him any information relating to unpaid parking violations that occurred at a time after the start of his day or after the start of his shift, because they would not have been added to the base station computer database from the mainframe computer until the next day or the next shift.

As it is claimed in claim 1, the present invention differs from the

system disclosed in the Cornelison reference in that in the present invention the parking attendant communicates directly by voice communication with the parking system receiving computer. The communication is not through an intermediate, stand-alone computer. The attendant also has available to him through direct communication with the parking system receiving computer current information identifying all parking system users who have logged in before his communication, because in the claimed invention the storage of parking information in the receiving computer takes place at the time a parking period is commenced by a parking system user. And the attendant, by direct two-way voice communication with the receiving computer with its up-to-the-minute information concerning vehicles that have logged into the parking system, can immediately determine whether a particular vehicle has properly commenced a parking period, even if that vehicle entered the parking system after the start of a day or after the start of a shift. The system disclosed in the Cornelison reference does not provide such up-to-the-minute information, and it is therefore not even suitable for the parking system monitoring purpose to which the present invention is directed, in addition to being a significantly different system from that claimed herein.

The Cornelison system also utilizes three computers, a stand-alone computer, a base station computer, and a mainframe computer, the latter of which contains the information. The present invention utilizes one computer, the receiving computer associated with the parking system, and it involves a direct two-way communication between the parking attendant and that single, receiving

system computer that contains the up-to-the-minute information relating to logged-in parking system users.

Also with respect to the Cornelison reference, it should be noted that it was also cited in the International Search Report that issued in connection with the corresponding PCT application. However, in the International Report on Patentability the international examiner concluded that the amended claims were found not to be obvious over the reported references, which included Cornelison.

In addition to the fact that each of the references relied upon relates to a different type of parking system, and therefore the references individually do not show or suggest the invention as claimed in claim 1, the references contain no suggestion or motivation for one to combine them as the examiner has done. It is not enough that disclosures could hypothetically be combined in some particular way. The mere possibility of combination does not make obvious a specific combination of particular elements of the references. The fact that particular individual elements of a claimed invention are known or could be found scattered in several different references is by itself insufficient to establish a prima facie case of obviousness. In that regard, all inventions are combinations of old elements. As was stated by former Chief Judge Markey of the Federal Circuit, "virtually all inventions are 'combinations,' and...every invention is formed of 'old elements'....Only God works from nothing. Man must work with old elements." H.T. Markey, "Why Not the Statute?" 65 J. Pat. Off. Soc'y. 331, 333-34 (1983).

But to be properly combinable the references must suggest the claimed combination itself. It is not sufficient that references merely disclose

individual elements or components that make up the claimed combination, because it is the specific, claimed combination of particular elements in a particular way, and not the mere existence of those elements, that must suggest the invention.

As noted above, none of the individual references relied upon by the examiner teaches the invention as claimed in claim 1, because each of the references relates to a different system and to a different method than that to which the present claims are directed. And significantly, the references do not contain any hint at all as to just how the various elements of each reference could be combined to arrive at the present invention as claimed. In that regard, it is not apparent from the references which features of which reference are to be combined with which features of another reference, and which features of which reference are to be ignored or discarded in order to arrive at a particular ultimate combination of features. Accordingly, the only apparent motivation for combining the references in the manner the examiner has done is the disclosure of the present application.

But to use as a road map or as a template an inventor's disclosure to aid in picking and choosing particular parts of particular references that allegedly can be combined, in order to attempt to render obvious that which only the inventor has taught, is an improper basis for rejection. The finding of obvious to combine in this case is based upon no more than conclusory statements of generalized advantages, and mere assumptions as to what an ordinarily skilled person would or would not do. It is not based upon teachings or suggestions in the references themselves. And, without any guidance from the references as to which features to include and which features to exclude, it is improper to selectively extract from

particular references particular features in order to arrive at a particular specific combination of features or elements.

Clearly, neither the Ilén reference, the Ouimet et al. reference, nor the Cornelison reference, by itself, teaches or suggests the claimed invention. But as noted above, those references also do not contain any hint or suggestion that would motivate one having only ordinary skill in the art to combine them in the precise way the examiner has done. Each of the references relied upon by the examiner relates to a different system, to a different problem, and to a different method than those to which the present invention is directed. And because of those differences, there would be no motivation to combine them.

Although one could assert broadly, as the examiner has done, that there exists a motivation to make a combination of particular features of particular references in a particular way to achieve a particular result, such a mere assertion, based only upon an after-the-fact rationalization of what an only ordinarily skilled person would do is insufficient. After all, one having only ordinary skill in the art would be governed by the conventional wisdom in the art and would not be led to innovate in the manner suggested by the examiner. In that regard, an ordinarily skilled person was characterized by the Court of Appeals for the Federal Circuit as follows:

> The issue of obviousness is determined entirely with reference to a hypothetical "person having ordinary skill in the art." It is only that hypothetical person who is presumed to be aware of all the pertinent prior art. The actual inventor's skill is irrelevant to the inquiry, and this is for a very important reason. The statutory emphasis is on a person of ordinary skill. Inventors, as a class, according to the concepts underlying the Constitution and the statutes that have created the patent system, possess something –

> call it what you will -- which sets them apart from the workers of ordinary skill, and one should not go about determining obviousness under § 103 by inquiring into what patentees (i.e., inventors) would have known or would likely have done, faced with the revelations of references. *A person of ordinary skill in the art is also presumed to be one who thinks along the line of conventional wisdom in the art and is not one who undertakes to innovate, whether by patient, and often expensive, systematic research or by extraordinary insights, it makes no difference which.* See the last sentence of § 103, supra.
> *Standard Oil Co. v. American Cyanimid Co.*, 227 U.S.P.Q. 293, 297-98 (Fed. Cir. 1985) (emphasis added).

And in assessing at what point in time the obviousness determination is to be made,

> To reach a proper determination under 35 U.S.C. 103, the examiner must step backward in time and into the shoes worn by the hypothetical "person of ordinary skill in the art" when the invention was unknown and just before it was made. In view of all factual information, the examiner must then make a determination whether the claimed invention "as a whole" would have been obvious at that time to that person. Knowledge of applicant's disclosure must be put aside in reaching this determination, yet kept in mind in order to determine the "differences," conduct the search and evaluate the "subject matter as a whole" of the invention. The tendency to resort to "hindsight" based upon applicant's disclosure is often difficult to avoid due to the very nature of the examination process. However, *impermissible hindsight must be avoided and the legal conclusion must be reached on the basis of the facts gleaned from the prior art.*
> M.P.E.P. § 2142 (emphasis added)

In this case, the facts contained in the references relied upon by the examiner do not teach or suggest the claimed invention.

Additionally, it has been held that for there to be a sufficient showing of a motivation to combine the teachings of several references, that motivation must be supported by referring to some relevant and identifiable source of information. After-the-fact rationalization and conclusory statements of

an examiner of possible advantages that could possibly lead one to combine the teachings of several references, and assumptions of what an ordinarily skilled person would or would not do, are by themselves inadequate to support a conclusion that there exists a motivation to combine references in a particular way. In that regard, the Federal Circuit explained the matter thusly:

> "The factual inquiry whether to combine references must be thorough and searching." Id. It must be based on objective evidence of record. This precedent has been reinforced in myriad decisions, and cannot be dispensed with....The examiner's conclusory statements that "the demonstration mode is just a programmable feature which can be used in many different device[s] for providing automatic introduction by adding the proper programming software" and that "another motivation would be that the automatic demonstration mode is user friendly and it functions as a tutorial" do not adequately address the issue of motivation to combine. This factual question of motivation is material to patentability, and could not be resolved on subjective belief and unknown authority. It is improper, in determining whether a person of ordinary skill would have been led to this combination of references, simply to "[use] that which the inventor taught against its teacher." W.L. Gore v. Garlock, Inc., 721 F.2d 1540, 1553, 220 USPQ 303, 312-13 (Fed. Cir. 1983).
> *In re Lee*, 277 F.3d 1338 (Fed. Cir. 2002)

Consequently, the merely hypothetical possibility of a subjective possible convenience that might be achieved by combining the teachings of different references is insufficient to support a conclusion of obviousness to combine. Clearly, the invention as claimed in claim 1 is directed to an invention that would not be obvious to one of only ordinary skill in the art based upon the disclosures contained in the references relied upon, and without having in mind the disclosure of the present invention.

Claims 2 and 4 though 8 each depend from claim 1, either directly or indirectly, and therefore the same distinctions as are noted above in

connection with claim 1 apply with equal effect to those dependent claims. Further, the dependent claims contain additional recitations that further distinguish the invention as so claimed from the teachings of the references relied upon.

Claim 3 was rejected as obvious based upon the Ilén, Ouimet et al., and Comelison references in view of the Katz reference. The Katz reference was cited merely for a disclosure of a grace period in connection with vehicle parking. That reference does not disclose voice communications, nor does it cure the deficiencies of the disclosures of the other references relied upon, nor does it contain any teaching or suggestion that would motivate one to combine the several references as the examiner has done to arrive at the method claimed in claim 3. Again, the only motivation to combine the references as the examiner has done in order to select particular parts of particular references and then to combine them is the present disclosure, not anything contained in the references themselves. Accordingly, the method as claimed in claim 3 would not be obvious to one of only ordinary skill in the art.

Based upon the foregoing amendments and remarks, the claims as they now stand in the application are believed clearly to be in allowable form in that they patentably distinguish over the disclosures contained in the references that were cited and relied upon by the examiner. Consequently, this application is believed now to be in condition for allowance, and reconsideration and reexamination of the application is respectfully requested with a view toward the issuance of a Notice of Allowance.

The examiner is cordially invited to telephone the undersigned attorney if this amendment raises any questions, so that any such question can be quickly resolved in order that the present application can proceed toward allowance.

Respectfully submitted,

May 10, 2006

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